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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/765,132	01/18/2001	Thaddeus I. Kingsford	58091-A CCD	7826
7590 07/13/2004				
Christopher C. Dunham c/o Cooper & Dunham LLP 1185 Avenue of the Americas New York, NY 10036			EXAMINER COMSTOCK, DAVID C	
			ART UNIT 3732	PAPER NUMBER

DATE MAILED: 07/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

08

Office Action Summary	Application No. 09/765,132	Applicant(s) KINGSFORD ET AL.	
	Examiner David Comstock	Art Unit 3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2004 and 18 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,8-10,18-21,29 and 30 is/are pending in the application.
- 4a) Of the above claim(s) 4,6 and 8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5,18-21,29 and 30 is/are rejected.
- 7) ☒ Claim(s) 9 and 10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Inventorship

In view of the papers filed 10 February 2003, the inventorship in this nonprovisional application has been changed by the deletion of Michael M. Malvar and Volker Schrepf. The sole remaining inventor of record is Thaddeus I. Kingsford.

The application will be forwarded to the Office of Initial Patent Examination (OIPE) for issuance of a corrected filing receipt, and correction of the file jacket and PTO PALM data to reflect the inventorship as corrected.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5, 29, and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Sarica (4,726,387).

Sarica discloses a cosmetic device comprising a manipulable applicator unit 2 including an applicator brush 3 and a material container unit, a receptacle 8 for a coherent body of material, and a cover 1A (see Fig. 1). A well 9 opens through the proximal end of the unit. The applicator is removably inserted into the well. The container unit includes a housing member 1B having a receptacle therein and a lateral

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opening in the side facing the cover. The receptacle is disposed distally of the well and opens laterally of the unit. The cover is manually movable and rotatable relative to the receptacle about a long geometrical axis of the container unit, i.e. the axis of the hinge 5. It is noted that the term "geometrical axis" lacks any specific limiting definition in the disclosure sufficient to preclude the term from encompassing the axis noted above, i.e. the axis of the hinge. Furthermore, it is noted that a geometrical axis, at least under a broadest reasonable interpretation, is a straight line about which a body rotates or may be conceived to rotate. Alternatively, it may be considered a line or line segment serving to orient a space or geometric object. Either way, the geometrical axis coincident with hinge 5, noted above, is well within the plain meaning of the term, since it is the line about which the cover (i.e. a body) rotates relative to the receptacle and about which the cover is oriented relative to the receptacle. Thus, the cover rotates relative to the receptacle about this geometrical axis (e.g. the receptacle may extend at an arbitrary 0° while the cover rotates about the axis and relative to the receptacle to, for example, a relative angle of 80°, when open). The well is positioned such that the applicator and the well are disposed in tandem along a long geometrical axis of the container unit. The handle of the applicator projects from the well when the applicator is positioned in the well. The container unit may contain "all types of cosmetics" which necessarily includes lip colorant (emphasis added, see col. 2, lines 23-25).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sarica (4,726,387).

Sarica discloses the claimed invention except for the cover being formed of transparent material. It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the cover of transparent material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sarica (4,726,387) in view of Giese et al. (5,655,553).

Sarica discloses the claimed invention except for the removable pan and the aperture in the receptacle. Giese et al. disclose a cosmetics compact 10 having a pan and apertures 52 in the receptacle 50 to allow pressure to be applied to the bottom of the pan through the holes in the receptacle to allow the pans to be removed and replaced without complication and to improve the convenience of the device (see Fig. 2; col. 1, lines 9-13 and 45-49; and col. 2, lines 1-5). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the

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compact of Sarica with a removable pan and an aperture in the receptacle, in view of Giese et al., in order to allow pressure to be applied to the bottom of the pan through the hole in the receptacle to allow the pan to be removed and replaced without complication and to improve the convenience of the device.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sarica (4,726,387) in view of Giese et al. (5,655,553) as applied to claim 19 above, and further in view of Ebbetts, III et al. (5,437,294).

The device of the combination of Sarica in view of Giese et al. discloses the claimed invention except for the pan being divided into a plurality of laterally opening compartments. Ebbetts, III et al. disclose a compact 10 having a pan divided into a plurality of laterally opening compartments 18 to allow cosmetics of different colors to be housed therein and improve the versatility of the device (see Fig. 3 and col. 4, lines 20-27). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the compact of Sarica and Giese et al. with a pan divided into a plurality of laterally opening compartments, in view of Ebbetts, III et al., in order to allow cosmetics of different colors to be housed therein and improve the versatility of the device.

Allowable Subject Matter

Claims 9 and 10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed 18 March 2004 have been fully considered but they are not persuasive.

In response to applicant's arguments that "relatively rotatable" means that one of the cover and the receptacle rotates relative to the other (applicant's arguments, page 6, lines 24-25), it is noted that the examiner agrees with this definition. However, as pointed out in the rejection, Sarica fully satisfies this language, since the cover rotates relative to the receptacle along the geometrical axis coincident with hinge 5, as pointed out in the rejection. For example, the receptacle may extend at an arbitrary 0° while the cover rotates about the axis and relative to the receptacle to, for example, a relative angle of 80°, when open.

In response to applicant's argument that because the lid pivots about the hinge, the device undergoes significant lateral expansion, which largely increases the lateral dimensions (see applicant's arguments, page 7, lines 13-17), it is noted that the limitation upon which applicant relies (i.e., preclusion of significant lateral expansion) is not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument that the hinge about which the cover and receptacle pivot is remote from the long geometrical axis (see applicant's arguments, page 8, lines 1-7), it is noted that applicant assumes that the long geometrical axis necessarily cannot be coincident with the axis about which hinge 5 pivots. However, as

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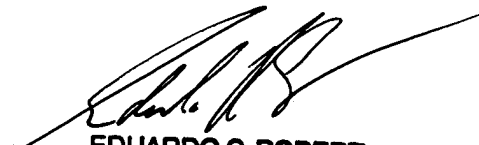
noted above, the term "geometrical axis" lacks any specific limiting definition in the disclosure sufficient to preclude the term from encompassing the axis noted above, i.e. the axis of the hinge. Furthermore, it is noted that a geometrical axis, at least under a broadest reasonable interpretation, is a straight line about which a body rotates or may be conceived to rotate. Alternatively, it may be considered a line or line segment serving to orient a space or geometric object. Either way, the geometrical axis coincident with hinge 5, noted above, is well within the plain meaning of the term, since it is the line about which the cover (i.e. a body) rotates relative to the receptacle and about which the cover is oriented relative to the receptacle. Thus, as already pointed out, the cover rotates relative to the receptacle about this geometrical axis (e.g. the receptacle may extend at an arbitrary 0° while the cover rotates about the axis and relative to the receptacle to, for example, a relative angle of 80°, when open). It is noted that the specification must clearly set forth the definition explicitly and with reasonable clarity, deliberateness, and precision. Exemplification is not an explicit definition. Even explicit definitions can be subject to varying interpretations. See *Teleflex, Inc. v. Ficosa North America Corp.*, 63 USPQ2d 1374, 1381 (Fed. Cir. 2002), *Rexnord Corp. v. Laitram Corp.*, 60 USPQ2d 1851, 1854 (Fed. Cir. 2001), and MPEP 2111.01.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Comstock whose telephone number is (703) 308-8514.



D.C. Comstock
08 July 2004


EDUARDO C. ROBERT
PRIMARY EXAMINER